



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,883	02/27/2002	Kari-Pekka Wilka	51020-012USC2	1197
42532	7590	10/29/2010		
PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110			EXAMINER DOAN, PHUOC HUU	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 10/29/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/085,883

Applicant(s)

WILSKA ET AL.

Examiner

PHUOC DOAN

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-83 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 68-83 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 42-67 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/08/2010 has been entered.

2. **Examiner Note:** in response to the Restriction Requirement dated Aug 2, 2010, Applicant elected Group II (claims 68-83) without traverse.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*,

Art Unit: 2617

759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may

sign a terminal disclaimer. A terminal disclaimer signed by the assignee

must fully comply with 37 CFR 3.73(b).

4. **Claims 68-83** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-76 of **U.S. Patent No. 6,427,078**. Although the conflicting claims are not identical, they are not patentably distinct from each other because Independent claim 1 of the present of application are broader in scope and thus encompass the subject matter already claimed in allowed US patent application 08/807,322 (Subject to be published as US Patent No: 6,427,078 on Jul. 30, 2002).

Specially claims **1, 24, 25, 55, 65, 69, 73** of the parent application recites a method, apparatus, corresponding to claim **68, 77** of the present of application with more details claimed in the parent application that would render the broader claims of the present of application obvious. For

example: claimed recited only different are “a mobile telephone unit housed by the housing and configured to (a) wirelessly transmit inputted image data to a remote location, (b) wirelessly transmit speech, and (c) wirelessly transmit text, wherein the application...destination for a wireless transmission of an image from a list of potential destinations” was conflict to claim **1, 24, 25, 55, 65, 69, 73** of the parent application.

Claim Rejections - 35 USC § 112

Claims 68, 77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 68, 77 recited “a mobile telephone unit housed by the housing and configured to (a) wirelessly transmit inputted image data to a remote location, (b) wirelessly transmit speech, and (c) wirelessly transmit text, wherein the application...destination for a wireless transmission of an image from a list of potential destinations” was not support by the original specification.

Claims 68, 77 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 68, 77, claimed recited “a mobile telephone unit housed by the housing and configured to (a) wirelessly transmit inputted image data to a remote location, (b) wirelessly transmit speech, and (c) wirelessly transmit text, wherein the application...destination for a wireless transmission of an image from a list of potential destinations”. How the application software includes a routine that enables a user to select a destination for a wireless transmission of an image from a list of potential destination. Thus, the claimed inventive are indefinite, for example, if the claimed limitations described a portable device or PDA has a function to use the specific of software application that are sending the SMS message or Email message where on the device has stored the telephone list or email address that allowed a user to select a destination for transmit.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 68-83 rejected under 35 U.S.C. 102(e) as being anticipated by Crane (US Patent No. 5,533,097).

As to claim 68, 77, Crane discloses a portable apparatus for communication and data collection comprising: a portable hand-held housing (See Abstract, col. 1, lines 5-21 “a microprocessor 301 within the briefcase 101 is incorporated in a portable housing included a handset 105, notepad 107, a digital camera”); a data processing unit housed by the housing and configured to run application software (col. 2, lines 22-37 “supports multiple communication protocols for format such as data, text, voice, audio, graphics, images, video”); a display housed by the housing and operably connected to the data processing unit (Fig. 3, col. 2, lines 60-65

"display on the notepad 107"); at least one user interface device housed by the housing and operably connected to the data processing unit (Fig. 3, col. 29-50, 10-42 "provided user interface device operated and controlled by microprocessor 301"); at least one memory housed by the housing and operably connected to the data processing unit for storing image data (col. 2, lines 25-45 "for storing image data in the storage 201") and for storing data from the data processing unit (col. 5, lines 45-67 "stored information and message controlled by microprocessor 301, for example, retrieved from a phone list in the internal data base within the memory for the microprocessor 301"); a data interface configured to input image data from a camera and route the inputted image data to the data processing unit (col. 2, lines 10-55); and a mobile telephone unit housed by the housing and configured to (a) wirelessly transmit inputted image data to a remote location (col. 2, lines 40-67 "the handset 105 provided voice, data, image communicate or transmitted"), (b) wirelessly transmit speech, and (c) wirelessly transmit text, wherein the application software includes a routine for storing images in the at least one memory (col. 2, lines 40-67, col. 3, lines 10-40), and wherein the application software includes a routine that enables a user to select a destination for a wireless transmission of an image from a list of potential destinations (Fig. 3, col. 2 through col. 3, lines 20, col. 4, lines 10-40

“internal data base with calendar, message , phone lists allowed a user to select a destination for wireless transmitted”).

As to claim 69, Crane further discloses the portable apparatus of claim 68, further comprising at least one battery that is housed within the housing and operatively connected to provide power to the portable apparatus (col. 3, lines 50-60).

As to claim 70, 78, 83, Crane further discloses the portable apparatus of claim 68, wherein the selection of a destination from the list of potential destinations operates differently depending on what application is being used (Fig. 3, col. 2 through col. 3, lines 20, col. 4, lines 10-40 “internal data base with calendar, message, phone lists allowed a user to select a destination for wireless transmitted”).

As to claim 71, 79, Crane further discloses the portable apparatus of claim 68, wherein the list has the capability to store telephone numbers and email addresses for a plurality of recipients (Fig. 3, item 301, col. 5, lines 60-65).

As to claim 72, 80, Crane further discloses the portable apparatus of claim 68, wherein the at least one user interface device comprises a keypad (Fig. 2 item 105 included keypad”).

As to claim 73, 75, 81, Crane further discloses the portable apparatus of claim 68, wherein the at least one user interface device comprises a digitizer pad (Fig. 2, item 017 included a digitized pad”).

As to claim 74, 82, Crane further discloses the portable apparatus of claim 68, wherein the at least one user interface device comprises a trackball (Fig. 2, item 213, key or replace trackball, it is inherently”).

As to claim 76, Crane further discloses the portable apparatus of claim 68, wherein the application software includes a routine that enables a user to select a phone number from a list (col. 2, lines 10-20, col. 5, lines 55-67).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawamura (US Patent No. 5,757,354) discloses portable data communication apparatus with rotatable display images for accommodating a wireless remote keyboard.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUOC DOAN whose telephone number is (571) 272-7920. The examiner can normally be reached on Mon-Tue, Thu-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LESTER KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PHUOC DOAN/
Examiner, Art Unit 2617